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In re Application of : **OFFICE OF PETITIONS**
Andrew L. Sternlicht :
Application No. 10/067,087 :
Filed: February 4, 2002 : **DECISION ON PETITION**
Attorney Docket No.: :
H0649/7001 RJB/CAB :

This is a decision on the Petition to Under 37 CFR 1.182, filed May 6, 2002 (Certificate of Mailing dated May 1, 2002), to accept a preliminary amendment as a complete application. The petition also requests that any new matter be accorded a filing date of May 1, 2002.

Background

The application was filed on February 4, 2002. On March 1, 2002, the Office of Initial Patent Examination mailed a Notice to File Missing Parts of Nonprovisional Application (hereinafter ("Notice")), stating that the application had been accorded a filing date, but noting that the basic filing fee, additional claim fees, the oath or declaration were missing from the application. The Notice further required substitute drawings in compliance with 37 CFR 1.84, and informed Applicant that page 36 of the specification, and drawing Figure 28B appeared to have been omitted from the application.

The mailing of a Notice of Omitted Item(s) will permit the applicant to either: (1) promptly establish prior receipt in the USPTO of the pages or drawing(s) at issue (generally by way of date-stamped postcard receipt (MPEP 503)) (by filing a petition under 37 CFR 1.53); (2) promptly submit the omitted page(s) or drawing(s) in a nonprovisional application and accept the date such submission as the application filing date (by filing a petition under 37 CFR 1.182); or (3) Accept the application as deposited in the USPTO [and not] respond to the Notice of Omitted Item(s), thereby constructively accepting the application as deposited with this Office. Amendment of the specification is required .

. . to renumber the pages consecutively and cancel any incomplete sentences caused by the absence of the omitted pages and/or cancel all references to the omitted drawing[s]. . . .
See MPEP 601.01(d) and (g).

Applicant responded with the instant petition wherein Applicant acknowledges that the application was filed without page 36 of the specification, and avers that drawing Figure 28B was in fact deposited with the Office on February 4, 2002 and included among 41 drawing sheets filed on that date; however, the drawing Figure was not labeled.

Subsequent to the filing of the petition, but before a decision on the merits could be rendered, the Office withdrew the Notice and issued a corrected Notice to File Missing Parts of Nonprovisional Application (hereinafter "corrected Notice"), on July 2, 2002. The corrected Notice informed Applicant that a filing date of February 4, 2002 had been accorded the application, but that the oath or declaration was missing from the application. Applicant was given two months from the mail date of the corrected Notice to supply the missing item.

A review of the application file reveal that the items required in the March 1, 2002 Notice - the basic filing fee, additional claim fees, and the oath or declaration, were in fact missing from the application on February 4, 2002. In addition, page 36 of the specification, and drawing Figure 28B appeared to have been omitted from the application.

A further review of the application file reveal that the basic filing fee and additional claim fees were filed with the instant petition on May 6, 2002. Applicant also re-filed the preliminary amendment, and an amended drawing Figure 28B to include the title of that Figure.

Accordingly, the March 1, 2002 Notice was withdrawn in error and the corrected Notice, mailed July 2, 2002, was mailed in error. As such, both the withdrawal of the Notice and the corrected Notice are hereby withdrawn.

Regarding the instant petition, Applicant avers that the preliminary amendment contains no new matter. Applicant is advised that a petition is not necessary in this instance to enter the preliminary amendment on the basis that the preliminary amendment contains no new matter. The issue of new matter is one appropriately addressed by the examiner.

Nor is a petition necessary to add the drawing figure. Applicants may also add figure(s) described in the specification on the basis that the drawings are not new matter. New drawings may be entered by the primary examiner without a petition so long as the drawings contain no new matter. See, MPEP 608.02(a).

It is obvious from the petition that no drawing was actually missing on February 4, 2002. Rather, the drawing of Figures 28B was simply not labeled as a result of Petitioner's filing error. However, the Notice, mailed March 1, 2002, was correct in stating that Figure 28B described in the specification appeared to have been omitted. The Notice was also correct in stating that page 36 of the specification appeared to have been omitted. Therefore, the Notice was properly mailed and will not be withdrawn.


Regarding applicants request to accord a filing date of May 1, 2002 (the date of the Certificate of Mailing of the instant petition and preliminary amendment), to any new matter that is filed with the instant petition, applicant is advised that Certificate of Mailing procedures described in 37 CFR 1.8 do not apply to the filing of a national patent specification and drawing or other correspondence for the purpose of obtaining an application filing date. See 37 CFR 1.8(a)(2)(i)(A). Any new matter contained in the preliminary amendment will be accorded a filing date of May 6, 2002.

The petition is dismissed.

Since the present petition was not necessitated by any error on the part of the Office, the \$130.00 petition fee will not be refunded.

The application is being forwarded to Technology Center Art Unit 3626 for consideration of the preliminary amendment, filed May 6, 2002.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-0014.


Derek L. Woods

Petitions Attorney
Office of Petitions